

REMARKS

Claims 1-26 are pending in the application. No claims are allowed. Claims 18-26 have been cancelled without prejudice.

Restriction Requirement

The application stands subject to a restriction requirement. The Examiner required an election between Group I to include claims 1-17, drawn to a cutter, card, and foam classified in class 604, subclass 11; Group II to include claims 18-20 and 25-26, drawn to a cutter and foam, classified in class 604, subclass 369; Group III to include claims 21-22 drawn to a cutter and card, classified in class 606, subclass 174; Group IV to include claims 23-24, drawn to a method of cutting foam, classified in class 83, subclass 13.

Applicant hereby elects, with traverse, to prosecute the claims of Group I Claims 1-17. The claims in Group II, claims 18-20 and 25-26, have been canceled without prejudice. The claims in Group III, claims 21-22, have been canceled without prejudice. The claims in Group IV, claims 23-24, have been canceled without prejudice. Applicant reserves the right to pursue the claims of Group II, III, and IV in a divisional application.

Election

The Office Action required an election between Species A as in Figure 4 and Species B as in Figure 8. This requirement is respectfully traversed.

Legal Threshold

The M.P.E.P. gives clear guidance for the issuance of a restriction. Under MPEP §806.04(b), “[s]pecies, while usually independent, may be related under the particular disclosure. Where inventions as disclosed and claimed are both (A) species under a claimed genus and (B) related, then the question of restriction must be determined by both the practice applicable to election of species and the practice applicable to other types of restrictions such as those covered in MPEP §806.05- §806.05(i). If restriction is improper under either practice, it should not be required.”

In order to sustain a proper restriction, the legal test is whether the individual groups are both “independent” and “distinct.” M.P.E.P. §808.01(a) and §806.05. “Independent” is defined in the context of restriction as having “no disclosed relationship” or “unconnected in design, operation, or effect.”¹ The examples given in the M.P.E.P. are having different modes of operation, different functions or different effects.²

First, independent claims 1 and 11, have numerous interrelated portions. A reading of the claims show that, by far, the similarities very much outweigh those things that are different. Thus, Applicant is unclear why an election between species is required. The figures perform similarly in operation, function, and effect.

“Distinct” is defined in the context of restriction as having a relationship, but are “capable of separate . . . use as claimed.”³ The distinctiveness prong is directed to combination-sub-combination type claims, process and apparatus for its practice, process and product made. In this context, the restriction fails to meet this legal prong.

¹ MPEP §802.01

² MPEP §806.04

³ MPEP §802.01

Moreover, the guidelines are crystal clear. Examiners must provide reasons and/or examples to support conclusions. "A mere statement of conclusion is inadequate."⁴ In the paper, there is absolutely NO reason and or examples for the election requirement. Applicant is unclear as to the Examiner's reasons for the election. As such, this falls extremely short of the required legal threshold.

Lastly, Although 35 U.S.C. 121 provides that restriction may be required to one or two or more independent and distinct inventions, 37 U.S.C. 1.141 provides that a reasonable number of species may still be claimed in one application.⁵ Since the legal threshold for a restriction is not met, it is respectfully asserted that this restriction is improper.

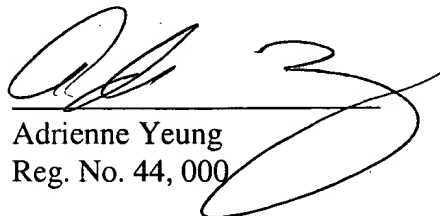
To further prosecution, Applicant elects Species A. However, this election is made with traverse and applicant formally requests that the Examiner provides reasons for this restriction.

Summary

It is believed that this Amendment places the above-identified patent application into condition for allowance. Early favorable consideration of this Amendment is earnestly solicited.

It is respectfully requested that the Examiner call the undersigned attorney at the number indicated below for an interview to expedite the prosecution of this application.

Respectfully submitted,
THELEN REID & PRIEST LLP



Adrienne Yeung
Reg. No. 44, 000

Dated: June 6, 2003

THELEN REID & PRIEST LLP
P.O. Box 640640
San Jose, CA 95164-0640
(408) 292-5800
(408) 287-8040

⁴ MPEP §816

⁵ MPEP §806.04(a)